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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/856,814

08/13/2001

Klaus Wilbuer

SWR-0055

4734

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7590

02/09/2004

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EXAMINER

UHLIR, NIKOLAS J

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/856,814

Applicant(s)

WILBUER ET AL.

Examiner

Nikolas J. Uhler

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1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: it is solely directed to the non-entered amendment.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1 and 5.

Claim(s) withdrawn from consideration: 6-44.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☒ Other: Initialed IDS attached

**Continuation of Box 2(a,c):** The proposed amendment will not be entered because it would insert a new limitation, namely a requirement that the coating be disposed on a work piece. The requirement that the claimed coating be disposed on a work piece was not earlier presented and thus is a new limitation that would require further search and consideration to determine patentability.

**Response to Arguments:** For the purpose of expediting examination of the application, the examiner feels it is beneficial to address applicant's arguments though they are solely directed to the limitations present in the non-entered amendment.

The applicant tendered the following argument:

The present Claims have been amended to specify that the coating is disposed on a workpiece. As described in the Specification:  
The layer-like design of the synthetic film and the possibilities of purposely influencing the properties in the individual areas also makes it possible, in combination with the possibility of information storage, to create applications-specific property profiles, so that a coating in the form of a synthetic film is available that can be used in many areas and that permits identification of the workpiece provided with the coating both during the whole production process and after it. Potential areas of application can be, for example, the food and pharmaceutical industries, environmental protection, connection and drive technology, shipping, fluid energy systems, the chemical and automobile industries or safety technology and stock protection.  
(Page 8, first 111 parapaph).

The present application is thus directed to coating for substrates such as workpieces made of metal of other known base materials as known in the mechanical engineering art. Yokoyama does not disclose a coating disposed on a workpiece as presently claimed. Instead, Yokoyama describes recording media such as floppy disks and the like. The nonmagnetic substrates of Yokoyama are clearly those suitable for formation of magnetic recording media and are not workpieces as presently claimed.

This argument is unpersuasive. The examiner notes that while it is the examiners duty to read the claims in light of the specification, it is also the examiners duty to give the claims their "broadest reasonable interpretation." Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's argument is moot because it is in reference to features that are not claimed.

Applicants have also argued that the non-magnetic substrates of Yokoyama are not work pieces as presently claimed because the work pieces referred to in the claims are made of materials known in the mechanical engineering art is also unpersuasive. The examiner notes that column 12, lines 64+ of Yokoyama disclose that the non-magnetic substrate can be formed of aluminum or aluminum alloy. Certainly one of ordinary skill in the mechanical engineering art would recognize aluminum or aluminum alloys as useful material. Thus, this argument is unpersuasive.

The bulk of applicant's arguments are centered around a commonly known principal in patent law, namely that to anticipate a claim, a reference must disclose each and every element of the claim. *Lewar Marine v. Variant Inc.* 3 U.S.P.Q2d 1766 (Fed. Cir. 1987). The examiner wholeheartedly agrees. To anticipate a claim, a reference must disclose each and every element **of the claim** (emphasis added). A reference need not disclose each and every element of the specification, as clearly elucidated by *In Re Van Geuns, supra*. The examiner maintains that arguments as to features of an invention that are not claimed **cannot** be considered to be persuasive.

TM

  
Paul Thibodeau  
Supervisory Patent Examiner  
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